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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/396,530 09/15/99 ADDINGTON

R 99-1802 WC

024253  
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QM22/0815

EXAMINER

PIERCE, W

ART UNIT

PAPER NUMBER

3711 6

DATE MAILED:

08/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/396,530

Applicant(s)

Addington et al.

Examiner

William M. Pierce

Group Art Unit

3711



☒ Responsive to communication(s) filed on May 19, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 14-30 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 14-30 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on May 19, 2000 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

  
WILLIAM M. PIERCE  
PRIMARY EXAMINER

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

1. Claims 14-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification.

The specification fails to discuss the steps as set forth in claims 14-30. This is a new matter rejection in that the specification fails to provide support for the claims as they are now amended.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the steps of claims 14-30 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

While the addition of fig. 9 is noted, it fails to illustrated all the steps recited in the claims.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Marinese et al.

Marinese shows a finger pad shield 1 in contact with a finger pad of a bowlers finger at 7b. The finger pad shield has a first and second surface at 7b and 3 respectively as shown in fig. 1. Fig. 1 shows inserting the finger pad into a finger hole of a bowling ball. The apparatus of

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Marinese transmits forces applied by the bowlers fingers to the finger pad and then to the bowling ball to control the release and the lift place on the ball as called for in steps c-f. While these “applying a first force”, “producing a second force” and how these forces interact with the finger pad and the bowling ball are not specifically disclosed, it is noted that in method claims, the prior art anticipates it if the device carries out the method during normal operation . (See MPEP 2112.02). Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. While the discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using. In re Huck , 114 USPQ 161, 163 (CCPA 1957). Such is not the case here since the apparatus of Marinese and the instant invention are being use to transmit forces from a bowlers hand to a bowling ball.

5. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Examiners comments with respect to claim 9 are set forth above. While the figure is acceptable it fails to meet the requirements to show each and every feature. While applicant appears to anticipate that this may be a grounds for further objection, he argues in addition that he does not have to use a flow chart to illustrate the claims. The examiner does not require a flow chart. He does require that drawings show every feature of the invention specified in the claims.

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A flow chart was a suggested way of doing this. Applicant may submit any other way of doing this that he may feel shows the claimed features. Thus, the drawings remain objected to.

Applicant goes on to try and show how the new claims are supported by the specification. Examiner does not agree as set forth in the grounds for rejection above under 35 USC 112, first paragraph. While applicant tries to point where every limitation are generally discussed in the specification, these citation do not support the detailed steps in the claims. For example, the specification does not discuss a “first force” and a “second force. Applicant tries to remedy this by stating (at the top of pg. 16) that how a bowler grips a ball is “generally well known”. However, while it is true that one knows how to grip a ball and deliver it, the steps of the claimed invention must be disclosed.

6. The declarations under 37 CFR 1.132 filed 5/19/00 are insufficient to overcome the rejection of claims 14-30 because they refer only to the invention described in the above referenced application and not to the individual claims of the application. While the declaration does refer to claims, these claim have been canceled and are no longer an issue. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. The declarations offer the opinions of the inventor and not facts which can be used as basis to overcome the grounds for rejection. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

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7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication should be directed to William Pierce at E-mail address [bill.pierce@USPTO.gov](mailto:bill.pierce@USPTO.gov) or at telephone number (703) 308-3551.



**WILLIAM M. PIERCE  
PRIMARY EXAMINER**